REMARKS

In the Office Action, the Examiner rejected claims 1-27 and 31-37 were rejected under 35 USC § 103(a). These rejections are fully traversed below.

Claims 1-27 and 31-37 are pending in the application. Claims 1, 8, 11, 13 and 20 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found throughout the specification and figures. No new matter has been added.

Reconsideration of the application is respectfully requested based on the following remarks.

Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Entry of this Amendment would not create substantially new issues, nor would it require significant further consideration or searching. Therefore, entry of this Amendment is appropriate and is respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 1-8, 10-21, 23-25, 31, 32, 34 and 37 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. (USP 7,251,826) in view of Meunier et al. (USP 6,681,369), and claims 9, 22, 26, 27, 33, 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. in view of Meunier et al. and further in view of Hollenbeck (US Pub. 2005/0102354). These rejections are respectfully traversed below.

Specifically, the Office Action appears to contend that Gardos teaches elements (a) through (d) of claim 1. Additionally, the Office Action states: "Gardos however does not explicitly teach that subsequent to the receiving (a) of the request to monitor the name, the searching (c) and the notifying (d) are periodically automatically performed. On the other hand, Meunier teaches monitoring agent which automatically tracks changes in documents (information) (column 5, lines 29-48), by periodically accessing the document or information and then notifying a user about the changes (col. 5, lines 49-

56)." The Applicants respectfully disagree for the reasons, among others, set forth below.

Applicant respectfully submits that Gardos is completely deficient. Claim 1 pertains to a computer-implemented method for monitoring domain name registrations. The method of claim 1 recites:

> (a) receiving a request to monitor a name, wherein the request to monitor is to identify at least one domain name that is similar to the name to be monitored and wherein the at least one similar domain name matches at least one domain variation of the name to be monitored;
> (b) determining a domain space about the name to be monitored, the domain space including the at least one domain variation of the name to be monitored;
> (c) searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored; and
> (d) notifying the requestor of the identified one or more registrations of domain names that have been identified by said searching (c) as matching the at least one variation of the name being monitored,
> wherein subsequent to said receiving (a) of the request to monitor the name, said searching (c) and said notifying (d) are periodically automatically performed.

As for element (a), "receiving a request to monitor a name, wherein the request to monitor is to identify at least one domain name that is similar to the name to be monitored and wherein the at least one similar domain name matches at least one domain variation of the name to be monitored...." In general, Gardos describes a system and method for managing existing domains. Gardos merely offers management of existing domains, not monitoring for domain name registrations. Gardos does not teach monitoring a name to identify at least one domain name that is similar to the name to be monitored. Gardos thus fails to teach or suggest element (a) of claim 1.

As for element (b), "determining a domain space about the name to be monitored, the domain space including the at least one domain variation of the name to be monitored", the Examiner points to Figs. 5 and 6. Fig. 5 merely allows a user to assign aliases to a particular domain [victoriakarol.com], and Fig. 6 merely allows the

user to specify mail servers for this particular domain. See Gardos, col. 7, line 60 to col. 8, line 46. Gardos thus fails to teach or suggest element (b) of claim 1.

As for element (c), "searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored", the Examiner points to Figs. 5, 6, 7, 9 and 10. The Examiner further asserts that "figures 5 and 6, ISP Manager allows entering a search (Figure 2) which results in retrieval of plurality of variations of domain name registrations that can be monitored." Applications respectfully disagree. The Examiner is simply picking and choosing portions of the prior art reference for a convenient rejection. As stated in Gardos, Figure 6 simply illustrates "the domain manager retrieves the aliases associated with a domain name to display the aliases and the domain names to which the aliases resolve. ... If no aliases have been established for the domain name, the www and ftp aliases are set to default settings." (Col. 7, lines 64-67 and Col. 8, lines 9-10. Contrary to the assertions alleged in the Office Action, Gardos does not teach searching a database to retrieve a plurality of variations of domain name registrations. Rather, Gardos teaches the use of default settings, which does not involve "searching a database of domain name registrations" as recited in claim 1. As such, Gardos does not teach or suggest "searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored" as recited in claim 1.

As for element (d), "notifying the requestor of the identified one or more registrations of domain names that have been identified by said searching (c) as matching the at least one variation of the name being monitored", the Examiner points to Figs. 5-10 and states that "notifying requestor of one or more registrations could be interpreted as displaying the result in response to the conducted search." The Examiner is improperly reading the prior art reference for a convenient rejection. While Figs. 5-10 of Gardos can display information concerned with management of a domain name, nothing in Gardos teaches or suggest anything about notifying a requestor of one or more registrations that are identified by the searching of element (c) for monitoring to identify one or more registrations of domain names that match the at least one variation of the name being monitored. Furthermore, Gardos does not teach or

suggest "notifying the requestor of the identified domain names that have been identified by the searching (c)" as recited in claim 1.

Accordingly, it is submitted that Gardos fails to teach or suggest any of elements (a) through (d) of claim 1.

The Office Action cites Meunier et al. for teaching that the operation of elements (a) through (d) are "periodically automatically performed" and alleges that even "though Meunier's art does not teach domain registration, the idea of performing predefined steps periodically in order to maintain most up-to-date data is well known." Applicants respectfully disagree. The Examiner is citing a non-analogous art to, again, simply provide another convenient rejection. Claim 1 is not directed to maintaining up-to-date data. Rather, claim 1 provides for the searching and notifying to periodically automatically occur in order to "identify one or more registrations of domain names that match the at least one variation of the name being monitored" and not to maintain up-to-date data. As stated previously, there is, therefore, no rational reason as to why one skilled in the art would seek to combine the domain management of Gardos with the document recommendation (e.g., document change information) of Meunier et al.

Accordingly, it is submitted that claim 1 is patentably distinct from Gardos and Meunier et al.

Claim 11 pertains to a method for monitoring domain name registrations. The method recites:

      (a) receiving a request to monitor a name;

      (b) searching a database of domain name registrations to identify one or more registrations of domain names that match the name being monitored;

      (c) notifying the requestor of the identified one or more registrations; and

      (d) sending warning messages to one or more registrants of the identified one or more registrations indicating that the identified one or more registrations are substantially similar to the name being monitored.

As stated in the Specification, in one example, "the warning message is transmitted 1016 to the offending registrant". (Specification, page 25, lines 13-15; See also Fig. 10). Thus, the notification is to the offending registrant.

Not only does Gardos fail to teach or suggest elements (a) through (c) of claim 11 for reasons similar to those noted above with respect to claim 1, but Gardos also fails to teach or suggest element (d) which sends warning messages to one or more registrants of those one or more registrations that have been identified, by the searching, as being substantially similar to the name that is monitored.

The Examiner continues to improperly equate the "warning messages to registrants of the identified one or more registrations" to the "authorization request from the administrative contact for the domain name" illustrated in Fig. 4. The Examiner maintains that "figure 4 is an example of warning message sent to a person attempting to search registrations database for a particular domain name" and that "Gardos teaches an operator who represents a group of registrations (i.e. agent), thus any communication sent to him from the domain manager is considered sending a warning (in case of error) message to registrants identified via search." Applicants respectfully disagree.

Nowhere does Gardos teach or suggest notifying the offending registrants. As stated previously, Gardos mentions an authorization email being sent; however, an authorization email such as used in Gardos is not a warning message to registrants of those one or more registrations that have been identified by the searching as matching the name being monitored. The email is sent to the client and not the offending "registrants of the identified one or more registrations" as recited in claim 11.

Accordingly, it is submitted that claim 11 is patentably distinct from Gardos and Meunier et al.

Claims 13 and 20 also pertain to method for monitoring domain name registrations. Elements (a) through (c) of claims 13 and 20 are similar to elements (a) through (c) of claim 11. Hence, for at least the associated reasons noted above with respect to claim 11, it is submitted that claims 13 and 20 are patentably distinct from Gardos and Meunier et al.

Hollenbeck et al. also does not overcome the various deficiencies of Gardos and Meunier et al.

Based on the foregoing, it is submitted that claims 1, 11, 13 and 20 are patentably distinct from Gardos, Meunier et al. and/or Hollenbeck et al. In addition, it is submitted that claims 2-10, 12, 14-19, 21-27 and 31-37 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Gardos, Meunier et al. and/or Hollenbeck et al.

Thus, it is respectfully requested that the Examiner withdraw the rejection of claims 1-27 and 31-37 under 35 USC § 103(a).

<u>Conclusion</u>

It is believed that above-identified patent application into condition for allowance. Early favorable consideration of this Response is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-0388 (Order No. RLC1G000).

Respectfully submitted,

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